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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,772

12/07/2005

Sergio Santini

5002-1083

5939

466

7590

04/14/2009

YOUNG & THOMPSON

209 Madison Street

Suite 500

ALEXANDRIA, VA 22314

EXAMINER

GUMBS, KEEGAN ROSS

ART UNIT

PAPER NUMBER

4128

MAIL DATE

DELIVERY MODE

04/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/559,772	Applicant(s) SANTINI ET AL.	
	Examiner KEEGAN GUMBS	Art Unit 4128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/07/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species 1 (claims 1-4 and 6) in the reply filed on 3/05/2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 5 and 7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species 2, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/05/2009.

Drawings

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract

Art Unit: 4128

on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Additionally the recitation "(The accompanying Figure 2 is to be published)" should be removed.

4. The disclosure is objected to because of the following informalities: The Information Disclosure Statement submitted on 12/07/2005, cites a reference Fukushima, Makoto being patent number (US 6,220,744); the correct patent number is (US 6,220,774).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

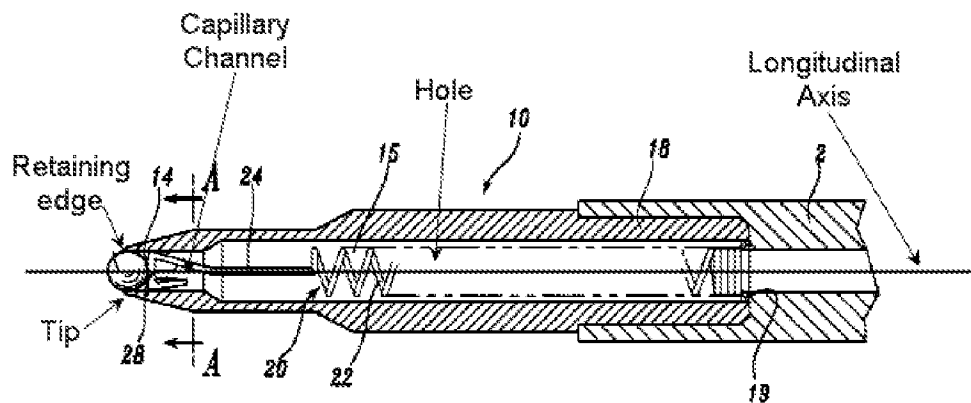
6. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim (US 6,193,429 B1), hereinafter Kim.

Regarding claim 1, Kim discloses a ball point pen (10) comprising a reservoir (2) communicating with a hole (15, see the annotated figure below) connected to a capillary channel (15, seen the annotated figure below) of a tip (see the annotated figure below)

Art Unit: 4128

which is provided with a cavity (16) which seats the ball (30) for writing, the ball being kept pressed against a retaining edge (see the annotated figure below) of the cavity as a result of the thrust of a compression-resilient spring (20) terminating in a straight portion (24 and 28) which is aligned with the a longitudinal axis of the ball-point pen (see the annotated figure below) and a free end of the spring is in contact with the ball (see Figure 8), characterized in that the capillary channel has means (14) which, coming into contact with the straight portion of the spring, prevent it from becoming inclined with respect to the longitudinal axis of the ball-point pen (see Figure 9).

(Member (14) prevents the straight portion of the spring from being inclined; see Figures 8 and 9.)



Regarding claim 2, Kim discloses that the capillary channel has a narrow section (14), through which the straight portion of the spring passes through, is designed with dimensions such as to contain the straight portion of the spring in an approximately complementary manner with a minimum amount of play (see Figure 8), substantially preventing the straight portion of the spring from assuming inclined positions with respect the longitudinal axis.

Art Unit: 4128

Regarding claim 3, Kim discloses one or more through-grooves (13) are formed in the region of the narrow section, the through-grooves connecting the cavity inside which the ball is seated to the hole with which the reservoir communicates (*see Figures 1, 8, and 9*).

Regarding claims 4 and 6, Kim discloses the narrow section is formed by a cylindrical shaped restriction (14) (*see Figure 9*).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rosenzweig patent publication (US 2004/0131413 A1), Fukushima patent (US 6,220,774 B1), Ando patent (US 6,805,511 B2), Kobayashi patent (US 6,554,521 B1), Togashi patent (US 6,322,270 B1), Shiobara et al. patent (US 5,984,559), Furukawa patent (US 5,876,142), Yoshii et al. patent (US 6,305,865 B1), and Okamoto et al. patent (US 5,277,510) disclose similar ball-point writing instruments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEEGAN GUMBS whose telephone number is (571)270-5608. The examiner can normally be reached on Monday through Friday 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Khoa Huynh can be reached on 5712724888. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4128

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KRG
AU 4128

/Khoa D. Huynh/
Supervisory Patent Examiner, Art Unit 4128